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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re My Virtual Model Inc.

Serial No. 76372314

Stephen J. Jeffries of Holland & Knight LLP for My Virtual Model Inc.

Cheryl L. Steplight, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Bucher, Zervas and Kuhlke, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

My Virtual Model Inc. seeks registration on the Principal Register of the following design mark:

for goods identified in the application as follows:

> "computer software, namely; computer software for on-line garment retailing applications that permits the end user to create and store a customized three dimensional on-screen model, apply three dimensional computerized versions of retailer specific garments to that model, and obtain garment size and fit recommendations and

other fashion advice based thereupon; computer software for on-line weight loss product retailing applications that permits the end user to create and store a customized three dimensional on-screen model to visualize weight loss and obtain fashion advice in relation thereto" in International Class 9.[1]

The Trademark Examining Attorney has taken the position that while the entire composite is registrable, the term "Virtual Model" is merely descriptive of the identified goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1). Applicant responded with evidence that it claims demonstrates acquired distinctiveness for this term. The Trademark Examining Attorney determined that the term is "highly descriptive," and that applicant's evidence was insufficient to establish that this highly descriptive term had acquired distinctiveness. Accordingly, this case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation under Section 6(a) of the Trademark Act in view of applicant's failure to comply with the requirement to disclaim the words VIRTUAL MODEL apart from the composite mark as shown above.

[1] Application Serial No. 76372314 was filed on February 19, 2002 based upon applicant's allegation of first use anywhere and first use in commerce at least as early as December 1, 1997. Applicant has amended the application to claim acquired distinctiveness as to the wording VIRTUAL MODEL.

Applicant and the Trademark Examining Attorney submitted briefs. Applicant did not request an oral hearing.

We reverse the refusal to register.

As to the term "Virtual Model," it is the Trademark Examining Attorney's position that this term is highly descriptive as applied to applicant's computer software. She argues that the term "Virtual" immediately informs the potential purchaser that applicant's goods involve computer simulations.[2] In additional to the submission of various dictionary entries, she points out that the term "Model" is used repeatedly in a descriptive manner by the applicant in the identification of goods herein.

Applicant counters that the wording "Virtual Model" has no common descriptive significance to online retailers or to consumers for garments or for weight loss products. It appears that the record does not show usage of this term by retailers of garments or weight loss products other than those who are affiliated with applicant.

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[2] In addition to the dictionary entries of record, the Trademark Examining Attorney cites to *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1526 (TTAB 2001) ["[P]eople have come to recognize that the term '*virtual*,' when used in connection with computers and related goods and services, means that someone at a computer is able to encounter certain things in a non-physical or 'virtual' manner."]

However, we agree with the Trademark Examining Attorney that it is clear that in other businesses, the concept of a "virtual model" seems to have an accepted meaning. For example, as additional support for her conclusions, the Trademark Examining Attorney submitted excerpted articles from her search of the LEXIS/NEXIS database. She argues that these excerpts demonstrate that the combined term, "virtual model," is highly descriptive of the function of applicant's simulation software:

> The articles evidence software products that enable the user to create a VIRTUAL MODEL of a home for decorating and design assistance. One can create a VIRTUAL MODEL of one's landscape for landscaping design. One can create a VIRTUAL MODEL of human building blocks for scientific research. And in the present case, one can create a VIRTUAL MODEL of one's self [sic] and try on clothes. If the users of these products (including applicant's) are not creating a VIRTUAL MODEL, then what are they creating? What terms can be used to describe the end result? The examining attorney argues that there are no other terms.

Nonetheless, applicant argues that

> "… the average customer must employ some degree of imagination, thought or perception to combine the relevant common (dictionary) meanings of the terms 'virtual' and 'model' to discern that Applicant's software products permit the end user to use the computer to create a three dimensional image of his [sic] or herself which will function as a 'clothes model' that the user can

> manipulate to ‘try on’ three dimensional images of clothing …”

Applicant’s appeal brief, p. 9.

The Trademark Examining Attorney points to the specimen of record, which instructs the user to “create your model” by “choosing a body shape that looks most like you.” Personal characteristics such as shoulder-to-hip relationship, bust size, skin color, hair color, etc., are used to build the model. Applicant’s literature says this software “… allows customers to create a virtual mannequin to ‘model’ items of clothing.” Once the selection process is completed, the user ends up with a three-dimensional, simulated, mirror image that looks “as much like you as you want” – or as one ad puts it, create “your virtual you.” Throughout applicant’s website and those of its affiliated partners, this simulated figure that mimics the customer’s body shape, is repeatedly referred to as “my model.” Once one’s “virtual model” is created, advice is offered about the types of clothes that will flatter the “model.” The model can then be sent to a “virtual dressing room” (or fitting room) to try on various outfits before the online customer makes the purchase in a way that makes the online shopping experience seem fairly realistic.

Applicant contends that while it is not the only source of computer software programs for online garment or weight loss product retailing applications marketed in the United States, that it has been, and remains, the only user of the phrase "Virtual Model" in connection with such software.

On the other hand, the Trademark Examining Attorney noted that the wording VIRTUAL MODEL had been disclaimed in applicant's previous registration for goods similar to those in the instant application, namely, "software which creates a virtual image of a person upon which clothing can be superimposed to guide the user in the choice of clothing."

;[3]

We find that by amending the application to set forth a claim of acquired distinctiveness for these two words, applicant has in effect conceded that the term "Virtual Model" is merely descriptive of its goods. Such a claim is

[3] Registration No. 2387229 issued to Public Technologies Multimedia, Inc. on September 19, 2000, assigned from Public Technologies Multimedia, Inc. to MYVIRTUALMODEL.COM INC. at Reel 2455, frame 0681; then assigned from MYVIRTUALMODEL.COM INC. to MY VIRTUAL MODEL INC. at Reel 2455, frame 0708.

tantamount to an admission that the term "Virtual Model" is not inherently distinctive and therefore is unregistrable on the Principal Register, in light of the prohibition in Section 2(e)(1) against merely descriptive marks, absent a disclaimer or a showing of acquired distinctiveness pursuant to Section 2(f). *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ["Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact"]. However, applicant clearly takes issue with the position of the Trademark Examining Attorney that this mark is "highly descriptive." Applicant argues that even if the wording "virtual model" should be deemed to be merely descriptive of applicant's goods, there is "no support for the Examining Attorney's determination that the wording 'virtual model' is 'highly descriptive' of Applicant's goods." Hence, this determination is the first issue we must decide.

It is clear from this record that people using the Internet expect interactivity, and such consumers have come to recognize in this context that the term "virtual" means

that someone at a computer is able to encounter things in a "virtual" manner. See *In re Styleclick.com Inc.*, *supra*. Users of applicant's website will readily understand that use of this application permits them to build a "virtual model" to represent themselves. While this record does not support a conclusion that this term is generic and forever denied registration, we find that on the *Abercrombie & Fitch* spectrum of distinctiveness of marks, the term is much closer to the "highly descriptive" end of the continuum than to the "merely suggestive" side.

Accordingly, we turn to whether applicant has sustained its burden of proof with respect to establishing a *prima facie* case that this highly descriptive term, "Virtual Model," has in fact acquired distinctiveness in connection with applicant's goods. Applicant has the burden of proving that its mark has acquired distinctiveness. *See In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"]. Logically, applicant's burden of demonstrating that its mark has acquired distinctiveness increases as the level of

descriptiveness increases. *Yamaha Int'l. Corp. v. Hoshino Gakki Co.*, 6 USPQ2d at 1008.

In this regard, applicant has submitted a variety of types of circumstantial evidence in support of its claim of acquired distinctiveness.

According to applicant's Supplemental Declaration of Acquired Distinctiveness under 37 C.F.R. §2.20 submitted on November 25, 2003, applicant has made substantially exclusive and continuous use in commerce of the "Virtual Model" term as a trademark in a number of different composite marks in connection with applicant's computer software for online garment retailing applications since 1997.

Certainly, the mere fact that applicant now has eight years of use of the term "Virtual Model" is by itself not sufficient for us to find that this highly descriptive term has acquired distinctiveness as a trademark. Hence, we must consider the other specific evidence of record.

In this context, applicant alleges that along with its licensees, it has expended more than five million dollars on promotional activities in connection with its "Virtual Model" formative marks over the past seven years. This has

included promotion via television, email, Internet advertisements, and the like.

Apparently, to date, more than six million consumers have registered to use applicant's computer software for online garment and weight loss product retailing applications offered under Applicant's "Virtual Model" formative marks.

Finally, applicant has provided examples of ways in which it has been the recipient of unsolicited publicity relating to its online computer software.

Accordingly, applicant argues that it has made out a *prima facie* case for the acquired distinctiveness of this term under Section 2(f) of the Trademark Act.

In reviewing the submitted declarations about how applicant does business, the number of its registered users and its promotional expenditures, we find that applicant has been using this term consistently in contexts that would condition customers to react to or recognize the designation VIRTUAL MODEL as an indication of source. Applicant uses this term in a technically correct trademark manner, and it has managed to register more than six million consumers as users of this software. Applicant's promotional expenses are fairly significant. While we

cannot know from this record exactly how applicant's Internet dollars were spent, applicant's success suggests to us that applicant's expenditure of more than five million dollars on promotional activities has been managed well. Applicant's promotional efforts have resulted in unsolicited publicity of a national character. Press clippings and articles made of record consistently use "My Virtual Model" (without the design feature) and "Virtual Model" (with upper case letters "V" and "M") when referring to applicant's software. Applicant's partnering efforts with national retailers such as Land's End, Levi's, Victoria's Secret, Sears, J.C. Penny, Kohl's, Guess?, Kenneth Cole, Lane Bryant, Limited Too, American Eagle Outfitters, etc., have helped to generate a large consumer base. In short, its advertising and promotional efforts have very clearly had a significant impact on the media and on purchasers. *See In re Kwik Lok Corporation*, 217 USPQ 1245, 1248 (TTAB 1983).

We also find it most relevant that despite competitive software packages for customizable 3-D mannequins available in the marketplace, it appears from this record that applicant continues to be the only user of the phrase "Virtual Model" in connection with such software.

Given the years of usage of this term by applicant on the Internet, accompanied by a showing of advertising expenditures of nearly a million dollars a year over a period of years, we conclude that applicant has proven acquired distinctiveness by a preponderance of the evidence. *See Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994) [the party attempting to establish legal protection for its mark has the burden of proving acquired distinctiveness by a preponderance of the evidence].

Decision: Although the term "Virtual Model" is highly descriptive of applicant's software, we find that applicant has proven acquired distinctiveness of this term by a preponderance of the evidence. Hence, we reverse the refusal of the Trademark Examining Attorney to register this designation under Section 6(a) of the Trademark Act in view of applicant's failure to comply with the requirement to disclaim the words VIRTUAL MODEL apart from the composite mark as shown above.